REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed December 21, 2005. In the Office Action, the Examiner notes that claims 1-24 are pending and rejected. By this response, Applicant has amended claim 21. All other claims continue unamended.

In view of both the amendments presented above and the following discussion, Applicant submits that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

OBJECTIONS

Priority

The Examiner states the "[T]he disclosure of the prior-filed application, Application No. 60/222784, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application." Applicant respectfully disagrees.

Specification

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. In response, Applicant has amended the specification to include at page 22 appropriate support for claim 16, such support being drawn from the provisional patent application upon which the instant patent application claims priority.

REJECTIONS

35 U.S.C. §102

Claims 1-6, 8-11, 13-17, and 20

The Examiner has rejected claims 1-6, 8-11, 13-17, and 20 under 35 U.S.C. §102(e) as being anticipated by Gordon WO 00/64170, hereinafter "Gordon." Applicant respectfully traverses the rejection.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Gordon reference fails to disclose each and every element of the claimed invention, as arranged in the claims.

Gordon, however, fails to teach or suggest each and every element of Applicant's invention of at least claim 1. Specifically, Applicant's independent claim 1 recites (independent claim 20 recites similar relevant limitations):

> "A method for delivering customized navigation imagery to a user, comprising:
> determining a profile associated with an encoded navigation stream, said profile including spatial and temporal parameters;
> encoding a video stream according to said profile to produce an encoded video stream, said encoded video stream representing imagery having associated with it a screen position and an image size;
> combining said encoded navigation stream and said encoded video stream to produce a combined stream representing navigation imagery including said video stream imagery, said video stream imagery having associated with it said screen position and said screen size."

In contrast to the above-quoted claim language, the Gordon reference fails to disclose or suggest at least the steps of: (1) "determining a profile associated with an encoded navigation stream...," and (2) "encoding a video stream according to said profile...."

Specifically, the subject invention operates to determine a profile associated with an encoded navigation stream. The claimed profile includes spatial and temporal parameters. The determined profile is then used to adapt

the encoding of a video stream. The previously encoded navigation stream and newly encoded video stream are then combined to produce a "combined stream representing navigation imagery including said video stream imagery...."

Gordon discloses a data structure and related methods associated with providing an interactive program guide. Of relevance to the instant patent application, the Examiner is referred to figure 4 of Gordon, which depicts a high-level block diagram of an interactive information distribution system. Of particular interest is the video profile module 460, which the Examiner apparently equates to the profiling functionality of the claimed invention. Page 17, lines 13-17 of Gordon state that:

> "the streams are generated in a synchronized manner with respect to a clock source 405, such that GOP structures, sequence headers, I-picture location and other parameters (which are indicated by the profile unit 460) are aligned across a plurality of information streams."

The above-quoted portion of Gordon, as well as an inspection of figure 4 of Gordon, reveals that Gordon merely teaches a video profile module 460 that is responsive only to a clock signal. The video profile module 460 does not receive input from any other functional element within the Gordon system. As such, to the extent that the video profile module 460 provides data to various video encoders, such data is predefined or otherwise static.

With respect to (1) "determining a profile associated with an encoded navigation stream...," it is noted that Gordon teaches no such step. Gordon simply does not utilize an encoded navigation stream. Therefore, there is no profile of such an encoded navigation stream to be determined. Therefore, there can be no step of determining.

With respect to (2) "encoding a video stream according to said profile...," it is noted that Gordon teaches no such step. As noted above, Gordon simply does not determine such a profile. Therefore, Gordon cannot be said to teach the utilization of such a determined profile.

In summary, to the extent that Gordon utilizes any encoded streams (video or otherwise), such streams are encoded at the same time. More

specifically, there is absolutely no teaching or suggestion in Gordon of any use of any video stream to determine a profile that is subsequently used to encode another video stream. The Gordon arrangement simply operates in a different manner than the claimed invention.

Therefore, Applicant submits that independent claim 1 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore, independent claim 20 recites features substantially similar to the features of claim 1. As such, for at least the reasons discussed above with respect to claim 1, independent claim 20 is also not anticipated by Gordon and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder.

Accordingly, Applicant submits that claims 1 and 20 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, claims 2-6, 8-11, and 13-17 depend, either directly or indirectly, from independent claim 1 and recite additional limitations therefor. As such, and for at least the same reasons as discussed above with respect to claim 1, Applicant submits that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Claims 21-25

The Examiner has rejected claims 21-25 under 35 U.S.C. §102(e) as being anticipated by Gordon 6,584,153, hereinafter "Gordon '153." Applicant respectfully traverses the rejection. However, to further prosecution Applicant has amended claim 21 to include relevant limitations similar to those found in independent claims 1 and 20. As such, and for at least the reasons discussed above with respect to claim 1, Applicant submits that claim 21 is allowable. Furthermore, claims 22-25 depend directly from independent claim 21 and recite additional limitations therefrom. As such, and for at least the reasons you discussed above with respect to claim 21, Applicant submits that these dependent claims are also not anticipated and fully satisfy the requirements of 35

U.S.C. §102 and are patentable thereunder. Therefore, Applicant respectfully requests that the rejection be withdrawn.

35 U.S.C. §103

Claim 12

The Examiner has rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Gordon. Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). Gordon fails to teach or suggest Applicant's invention as a whole.

Claim 12 is patentable for at least the reasons discussed above with respect to claim 1 from which it depends (i.e., Gordon fails to teach or suggest each and every element of Applicant's invention of claim 1).

Additionally, Applicant does not necessarily agree with the Examiner's official notice regarding the updating of demographic data. Though such updating may now be well known, the instant application was filed in 2001 and claims priority to a provisional application filed in 2000. However, in view of the patentability of claim 1 over the Gordon reference, there appears to be little need to investigate the propriety of the official notice, though Applicant reserves the right to such a request.

Claim 7

The Examiner has rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Gordon in view of Gordon WO 01/031914, hereinafter Gordon 031914, and in further view of Kondo 200500189116, hereinafter "Kondo." Applicant respectfully traverses the rejection.

Claim 7 is patentable for at least the reasons discussed above with respect to claim 1, from which it depends. Specifically, the Gordon reference, the Gordon 031914 reference, and the Kondo references either singly or in any allowable combination, fail to disclose or suggest the limitations discussed above with respect to claim 1; namely the steps of "determining" and "encoding" discussed above with respect to claims 1 and 20. Thus, claim 1 is patentable over any combination of these references. Moreover, since claim 7 depends indirectly from claim 1 and recites additional limitations therefrom, claim 7 is also patentable over these references.

Claim 18

The Examiner has rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Gordon in view of Gordon 031914. Applicant respectfully traverses the rejection.

Claim 18 is patentable for at least the reasons discussed above with respect to claim 1, from which it depends. Specifically, the Gordon references either singly or in any allowable combination, fail to disclose or suggest the limitations discussed above with respect to claim 1; namely the steps of "determining" and "encoding" discussed above with respect to claims 1 and 20. Thus, claim 1 is patentable over any combination of these references. Moreover, since claim 18 depends indirectly from claim 1 and recites additional limitations therefrom, claim 18 is also patentable over these references.

Claim 19

The Examiner has rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Gordon in view of Gordon 031914, and in further view of Boucher et al 6,675,387, hereinafter "Boucher," hereinafter "Boucher." Applicant respectfully traverses the rejection.

Claim 19 is patentable for at least the reasons discussed above with respect to claim 1, from which it depends. Specifically, the Gordon references and the Boucher reference, either singly or in any allowable combination, fail to

disclose or suggest the limitations discussed above with respect to claim 1; namely the steps of "determining" and "encoding" discussed above with respect to claims 1 and 20. Thus, claim 1 is patentable over any combination of these references. Moreover, since claim 19 depends indirectly from claim 1 and recites additional limitations therefrom, claim 19 is also patentable over these references.

SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicant's disclosure than the primary references cited in the Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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